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09/705,411	11/03/2000	Michael Nowak	Y2K.0090	6773

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EXAMINER

HEWITT, JAMES M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 08/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/705,411

Applicant(s)

NOWAK, MICHAEL

Examiner

James M Hewitt

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 5/19/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 3-6 and 9-12 are objected to because of the following informalities:

In claim 3 lines 6-9, as it is apparent that the at least one aperture of the frame and the at least one aperture of the fastening means are one and the same, limitation (c) should be deleted and limitation (b) should be rewritten to state "the fastening means includes at least one aperture to secure the frame and advertising device to the vehicle". Note that claim 2, from which claim 3 depends, recites that the frame includes a fastening means to secure the frame to the vehicle.

Claim 5 should be canceled for the following: As claim 5 depends from claim 2, limitation (b) in claim 5 should be amended to state that the fastening means includes the at least one aperture for securing the frame to the vehicle because the at least one aperture of the frame is one and the same as the at least one aperture of the fastening means. After making said amendment in order to overcome the objection, claim 5 would be a duplicate of claim 3 (as amended).

In claim 9 lines 6-9, as it is apparent that the at least one aperture of the frame and the at least one aperture of the fastening means are one and the same, limitation (c) should be deleted and limitation (b) should be rewritten to state "the fastening means includes at least one aperture to secure the frame and advertising device to the vehicle". Note that claim 8, from which claim 9

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depends, recites that the frame includes a fastening means to secure the frame to the vehicle.

In claim 10 line 2, the phrase "further comprising" should be replaced with "wherein" in order to clarify the claim.

Claim 11 should be canceled for the following: As claim 11 depends from claim 8, limitation (b) in claim 11 should be amended to state that the fastening means includes the at least one aperture for securing the frame to the vehicle because the at least one aperture of the frame is one and the same as the at least one aperture of the fastening means. After making said amendment in order to overcome the objection, claim 11 would be a duplicate of claim 9 (as amended).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Bulka (US 5,343,647).

With particular reference to Figures 1 and 2, Bulka discloses an advertising device adapted for mounting on a vehicle, the device comprising a

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frame (11) and a center section (15) forming the advertising device; the device being adapted for securing to a license plate area of a vehicle; the frame being securable to the vehicle; the frame and the center section being adapted to have advertising thereon; and the frame being separable from the center section.

Note the following definition of "advertisement":

**ad·ver·tise·ment** (əd'vɜr-tīz'ment, əd-vûr'tīs-, -tīz-) *noun*

1. The act of advertising.
2. A notice, such as a poster, newspaper display, or paid announcement in the electronic media, designed to attract public attention or patronage.<sup>1</sup>

With respect to claim 2, wherein the frame has at least one slit separating the center portion from the frame; the frame having at least one tab connecting the center portion to the frame; the at least one tab being adapted for severing the center portion from the frame; the frame including a fastening means (20) to secure the frame to the vehicle.

The periphery of the label (15) is die-cut through the label and the first face (12) of the panel (11) thus defining the shape of the label and permitting releasable attachment to the panel. As is known in the art, die-cutting or scoring produces a series of slits and tabs.

With respect to claim 3, wherein the tab facilitates separation of the center portion from the frame; the fastening means including at least one aperture (20).

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With respect to claim 4, wherein the device is generally rectangular.

With respect to claims 5 and 6, refer to the rejections of claims 3 and 4.

With respect to claims 1-6, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

It has also been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solow (US 4,819,355) in view of Pleotis (US 6,262,807)

With respect to claim 7, Solow discloses a vehicle license plate frame having fastening apertures (20, 22) and removable center sections (28, 30). Solow fails to teach that the frame may include advertising. Pleotis, in Figure 9, teaches a vehicle license plate frame having advertising thereon. In view of Pleotis' teaching, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ advertising on Solow's frame in order to call attention to a product or business.

With respect to claims 8-12, Solow's license plate frame is generally rectangular. Solow's removable center sections are attached by frangible joints in the form of grooves. It is unclear whether these joints comprise tabs and slits (scoring). Nevertheless, it would have been obvious to one having ordinary skill in the art to removably attach Solow's center sections via scoring (another type of frangible joint) as a matter of design choice or an alternative means by which to frangibly attach the center sections.

### ***Response to Arguments***

Applicant's arguments filed 5/19/04 have been fully considered but they are not persuasive.

Regarding the rejection of claims 1-6, Applicant argues that Bulka provides no disclosure of the use of his device with a vehicle. The claimed invention (claims 1-6) only requires that the device is "for mounting on a vehicle",

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or is "adapted for securing to a license plate area of a vehicle", or is "securable to the vehicle". And as described above, Bulka's device is considered to meet all of these functional limitations, in that Bulka's device is able to be secured or mounted to a license plate area of a vehicle. For instance, a string could be looped through Bulka's aperture (20) and through a license plate mounting aperture on a vehicle to secure Bulka's device to the vehicle.

Applicant's arguments with respect to claims 7-12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will



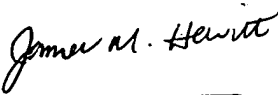
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the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M Hewitt whose telephone number is 703-305-0552. The examiner can normally be reached on M-F, 930am-600pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**JAMES M. HEWITT**  
**PRIMARY EXAMINER**